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EXAMINER

BURLESON, MICHAEL L

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,503

Applicant(s)

CHAPMAN, EDWARD NEIL

Examiner

Michael Burleson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Response to Arguments

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Regarding claims 1-20, It appears that applicant made an attempt to disqualify the reference of Hansen US 6509974 as prior art by submitting a terminal disclaimer. However, MPEP 718 states that these measures should be taken when the claims are rejected under 35 USC 103, using a reference that is not prior art under 35 USC 102 (b). A 35 USC 103 rejection was not made by Examiner therefore, the previous office action stating the deficiency of the declaration still remains.

DETAILED ACTION

1. The Declaration filed on December 6, 2000 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hansen US 6509974 reference.
2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Hansen US 6509974 reference.
3. Applicant has not, to the examiners satisfaction, shown that the instant application was reduced to practice prior to May 17, 2000, the effective date of the Hansen US 6509974 reference. Applicant has simply provided a general background

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and summary of alleged support for his submission that the instant application was reduced to practice prior to the effective filing date of the cited prior art. Therefore, the evidence submitted is not enough to show, that the instant application was reduced to practice prior to May 17, 2000. The Applicant does not show facts supporting completion of the invention as claimed. The grounds for rejection are therefore maintained.

4. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hansen US 6509974 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

5. Applicant has simply provided a general background and summary of the instant application. However, there is no proof based on the evidence submitted by Applicant, that the instant application was conceived prior to May 17, 2000.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hansen US 6509974.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Hansen teaches that the stations (114) can be configured to read many different electronic file formats (column 4, lines 26-30), which reads on receiving an input of an application file. He teaches of different types of document features that can be selected (column 6, lines 24-31), which reads on selecting a

preferential document-processing feature from a group of document-processing features for a print job. Hansen also teaches of a plug in that contains a new feature or function (column 13, lines 4-6), which reads on applying a plug-in module, for supporting the preferential document-processing feature, to the application file.

Regarding claim 2, Hansen teaches of a print production stage (108), in which the final form of the documents are sent to a print server (120), which is then sent to the desired output device (122) (column 6, lines 62-67). This reads on at least a portion of the application file using the plug-in module for the print job.

Regarding claim 3, Hansen teaches of ready for printer file format, which include Portable Format Document (PDF), Postscript and printer control language (PCL) (column 4, lines 34-38), which reads on a page description language file selected from the group consisting of a Portable Format Document (PDF), Postscript and printer control language (PCL).

Regarding claim 4, Hansen teaches that a ready for printer file format is interpreted by the internal processing engine of the print engine and converts non-ready for printer file formats into ready for printer file format (column 5, lines 22-37), which reads on determining whether or not the application file represents a page description language file; converting the received application file into a page description language file if the received application file does not represent a page description file.

Regarding claim 5, Hansen teaches of a desktop (302) that is structured as a plug in architecture, which allows enhancements and updates (column 12, lines 62-67

and column 13, lines 1-4), which reads on accessing a plug-in module database to retrieve the selected plug-in module.

Regarding claim 6, Hansen teaches that the stations (114) can be configured to read many different electronic file formats (column 4, lines 26-30), which reads on receiving an input of an application file. He teaches the internal processing engine of the print engine and converts non-ready for printer file formats into ready for printer file format (column 5, lines 22-37), which reads on converting the application file into a page description language file if the application file is in a format distinct from the page description language file format. He teaches of different types of document features that can be selected (column 6, lines 24-31), which reads on selecting a preferential document-processing feature from a group of document-processing features for a print job. Hansen also teaches the job preparation station (116) prints the job (column 5, lines 59-62), which reads on printing the page description language file using the selected plug-in module for a print job.

Regarding claim 7, claim 7 is rejected for the same reasons as claim 3.

Regarding claim 8, claim 8 is rejected for the same reasons as claim 5.

Regarding claim 9, Hansen teaches of an internal processing engine that interprets whether a file is a ready for printer file format or not (column 5, lines 22-44), which reads on a detector for receiving an input of an application file and determining whether the application file represents a page description language file. He teaches of a GUI interface represented on workstation (116) that allows manipulation of documents (column 8, lines 59-67 and column 9, lines 1-5), which reads on a user interface for

selecting a preferential document-processing feature from a group of document-processing features. Hansen also teaches that the prepared documents are submitted to a production output device (122) (column 8, lines 37-40), which reads on printer for applying a plug-in module, associated with the preferential document-processing features, to the application file.

Regarding claim 10, Hansen teaches of RIP'ing (Raster Image Processor) a job prior to being sent to a device (122) (column 7, lines 7-10), which reads on a bitmap printing module for printing the application file.

Regarding claim 11, claim 11 is rejected for the same reasons as claim 3

Regarding claim 12, Hansen teaches that the computer automatically converts the documents into a ready for printer format file (column 2, lines 39-41), which reads on a converter for converting the application file to a page description language file if the application file does not represent a page description language file.

Regarding claim 13, Hansen teaches the print server (120) detects the attributes of the job (column 18, lines 29-32), which reads on a customization detector configured to detect whether customization data is associated with the application file. Hansen shows that the print server (120) and workstation (116), which reads on plug-in selector, where the desktop (302) is located are connected (figures 1a and 1b), which reads on the plug-in selector in communication with the customization detector and the plug-in database for selecting an active plug-in module based on the customization data.

Regarding claim 14, Hansen teaches of an internal processing engine that interprets whether a file is a ready for printer file format or not (column 5, lines 22-44),

which reads on a detector for receiving an input of an application file and determining whether the application file represents a page description language file. Hansen teaches of workstation (116), which provides the ability to modify documents (column 6, lines 20-31), which reads on a data augementer for associating a preferential document-processing feature with the application file. Hansen also teaches of a desktop (302), which selects plug-ins (column 12, lines 62-67 and column 13, lines 1-9), which reads on a plug-in selector for selecting a plug-in module for supporting the document-processing feature.

Regarding claim 15, teaches of a production output device (122) such as a printer (column 7, lines 46-48), which reads on a printer for printing the application file using the selected plug-in module.

Regarding claim 16, claim 16 is rejected for the same reasons as claim 3

Regarding claim 17, claim 17 is rejected for the same reasons as claim 12

Regarding claim 18, Hansen teaches of a desktop (302) in which a main program code looks for plug-ins (column 12, lines 62-67 and column 13, lines 1-9), which reads on the plug-in selector is adapted to access a plug-in database to retrieve the selected plug-in module.

Regarding claim 19, Hansen teaches of a file downloader used by the production output device (122) (column 8, lines 36-40 and figures 1a and 1b), which reads on the data augementer cooperates with a downloader to express the preferential document-processing feature as a downloader-embedded customization data in the application file.

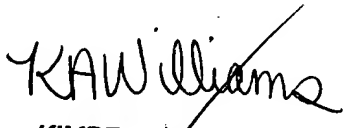
Regarding claim 20, Hansen teaches that the job is sent from the job preparation stations (116) to the production output devices (122) to be printed (column 6, lines 1-3 and column 11, lines 53-55). It is inherent that the production output device (122) contains a printer driver because it prints the job sent by the job preparation station (116), which reads on the data augementer cooperates with a printer driver to express the preferential document-processing feature as printer-driver-embedded customization data in the application file.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

1. Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (571) 272-7460 and fax number is (571) 273-7460. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at (571) 272-7471.


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER

Michael Burleson
Patent Examiner
Art Unit 2626



MIb
August 24, 2005